

REMARKS

The specification has been amended to indicate the serial numbers for the listed co-pending applications. Claims 7, 18, and 22-24 have been canceled without prejudice or disclaimer as to the subject matter recited therein. In addition, claims 1, 2, 8, 12, 19, and 21 have been amended. Claims 1-6, 8-17, and 19-21 remain pending in the captioned case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Objection to the Claims

An objection was lodged against claim 21 as being in improper form. In response thereto, claim 21 has been amended to correct its dependency. Accordingly, Applicants respectfully request removal of this objection.

Section 112 Rejection

Claims 1-11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In response thereto, claim 1 has been amended in a manner believed to address the concerns in the Office Action. Accordingly, Applicants respectfully request removal of this objection.

Section 102 Rejection

Claims 1, 4-6, 11, 12, 15-17, and 22-24 were rejected under 35 U.S.C. § 102(e) as being anticipated over U.S. Patent No. 6,675,230 to Lewallen (hereinafter "Lewallen"). In response thereto, the subject matter from dependent claims 7 and 18 has been placed into independent claims 1 and 12, respectively. The Office Action states on page 6, paragraph 17, and page 7, paragraph 19, that Lewallen does not teach the subject matter of claims 7 and 18, respectively. Accordingly, Applicant asserts that newly amended independent claims 1 and 12, as well as claims dependent therefrom, are now allowable over Lewallen.

Section 103 Rejection

Claims 2, 3, 13, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewallen in view of U.S. Patent No. 6,496,202 to Prinzing (hereinafter "Prinzing"). In addition, claims 7 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewallen in view of an article entitled "Rapid Java Application Development Using JBUILDER 3" by Liang (hereinafter "Liang"). Moreover, claims 8-10 and 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewallen, Liang, and U.S. Patent No. 6,161,107 to Stern (hereinafter "Stern").

The primary reference to Lewallen is not available as prior art for the current rejection. As noted above, claims 2, 3, 7-10, 13, 14, and 18-21 were rejected over a combination of Lewallen, Prinzing, Liang, and Stern. As will be set forth in more detail below, Lewallen is not usable in a 35 U.S.C. § 103 rejection since it was commonly owned with the present application at the time the subject invention was made and was not published prior to the filing of the present application.

Under the American Inventors Protection Act of 1999 ("the AIPA"), prior art available only under 35 U.S.C. § 102(e) is not usable in a 35 U.S.C. § 103 rejection if the art meets the common ownership requirements of 35 U.S.C. § 103(c) as amended. The following is a quotation of the revised 35 U.S.C. § 103(c) (as of December 14, 2000):

Subject matter developed by another person, which qualifies as prior art only under one of more of subsections (c), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The AIPA amended 35 U.S.C. § 103(c) to state that art which qualifies as prior art only under 35 U.S.C. §§ 102(c), (f), or (g) is not available for rejections under 35 U.S.C. § 103 if that art was commonly owned or subject to an obligation of assignment at the time the subject invention was made. This change to 35 U.S.C. § 103(c) is effective for any application filed on or after November 29, 1999.

It is noted that upon filing of the present application, the patent to Lewallen and the present application were commonly owned by or subject to an obligation of assignment to the same assignee, International Business Machines of Armonk, NY. In addition, the present application was filed after

November 29, 1999 and is subject to the amendments to § 103(c) made by the AIPA. Consequently, Lewallen is not available as prior art against claims of the present application.

Since Lewallen is not available as prior art under the current rejection, no combination of Lewallen with other cited art may be used for the current rejection. As such, the combination of the references cited in the Office Action for the § 103(a) rejections cannot be used against the presently claimed case.

The cited art does not teach or suggest a functionality lacked by the first API comprises support for Unicode font encoding and font searching capability. Each of the present independent claims recite a first API adapted to execute code for the display of images. This first API lacks functionality provided by a second API. Moreover, the functionality lacked by the first API comprises support for Unicode font encoding and font searching capability. Contrary to the limitations of the present independent claims, nowhere in Prinzing, Liang, or Stern is there any mention or suggestion, either hypothetically inherent within a single reference, or a combination of references, the limitation that a first API generates an image with a consistent look and feel, yet lacks functionality provided by a second API, with the lacking functionality being support for Unicode font encoding and font searching capability. Moreover, the cited references do not suggest incorporating into the first API software components to confer or provide some functionality present in the second API.

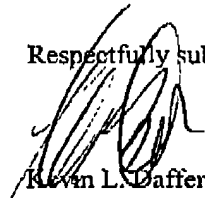
Given the deficiencies of the Lewallen as a primary reference and the failure of the secondary references to teach or suggest that which is presently claimed in the independent claims, Applicant asserts that independent claims 1 and 12, as well as claims dependent therefrom, are patentable over the cited art. Accordingly, removal of this rejection is respectfully requested.

CONCLUSION

The present amendment and response is believed to be a complete response to the issues raised in the Office Action mailed November 10, 2004. In view of the remarks traversing the rejections, Applicants assert that pending claims 1-6, 8-17, and 19-21 are in condition for allowance. If the Examiner has any questions, comments or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 09-0447.

Respectfully submitted,



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